

## REMARKS

### New Claims

New claims 34-36 replace claims 31-33. New claims 37-48 are directed to the elected subject matter. These new claims do not raise new issues so their addition is appropriate under 37 C.F.R. § 1.116.

### Election/Restriction

In finding the search burdensome, the invention as a whole has not been considered. If only ½ of the molecule is considered (a urea group and pyridine) then only ½ of the common core is considered in defining the search. A search so defined will certainly be broader than is necessary. The portion of the common core which has not been considered is one of the required substituents that appears on the cyclic moiety L' of the structure – L-(ML'). These substituents further define the ureido compounds such that a structure search based on the true common core would not produce results which are too burdensome to investigate.

### Rejection Under 35 USC §112, first paragraph

One skilled in the art would recognize that the methods for preparing ureas disclosed in the specification, such as from isocyanate and aniline starting materials, can be modified to employ distinct starting materials. More than one route to the intermediates and final products are described, such that it would not be undue experimentation to prepare the heterocyclic compounds encompassed by the claims. In making a non-enablement rejection under 35 USC §112, first paragraph, it is incumbent upon the PTO to present evidence to the contrary. See e.g., *In re Marzocchi*, 169 USPQ 367, 369 (CCPA 1971) and *Fiers v. Sugano*, 25 USPQ2d 1601, 1607 (Fed. Cir. 1993). The rejection fails to provide any evidence to support the assertion of non-enablement. The broad scope of the claims does not equate to undue experimentation in practicing their full scope.

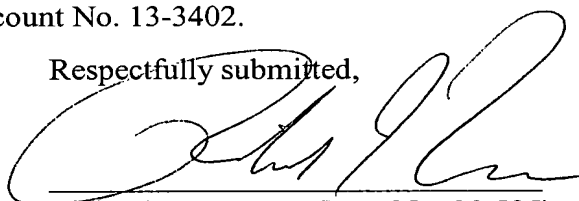
Applicants maintain this rejection is based on an unsupported conclusion. The

application provides general preparative methods on pages 12-16 to guide one skilled in the art to prepare the claimed compounds. Numerous references are also identified on page 12 for obtaining the desired starting materials. The specification also discloses how to prepare pharmaceutical agents with the compounds of the invention and how to administer them on pages 16-21 of the specification. Pages 25-61 provide greater detail in preparing certain starting materials and intermediates as well as procedures to use these materials to prepare the claimed compounds. On pages 62-85, the synthesis of over 100 compounds is provided. In view of this general and detailed description, the specification clearly provides an enabling disclosure for the subject matter claimed.

It is respectfully submitted that Applicants' specification provides more than sufficient disclosure to objectively enable one of ordinary skill in the art to make and use the claimed compounds. Therefore, withdrawal of the rejection under 35 USC §112, first paragraph, and the allowance of all pending claims is respectfully requested.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



Richard J. Traverso (Reg. No. 30,595)  
Attorney/Agent for Applicant(s)

MILLEN, WHITE, ZELANO  
& BRANIGAN, P.C.  
Arlington Courthouse Plaza 1, Suite 1400  
2200 Clarendon Boulevard  
Arlington, Virginia 22201  
Telephone: (703) 243-6333  
Facsimile: (703) 243-6410

Attorney Docket No.: BAYER 15P3

Date: **December 23, 2002**

K:\Bayer\15P3\reply12-23-02t